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Hau H. Duong

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12/15/2008

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EXAMINER

LU, FRANK WEI MIN

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

12/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**DETAILED ACTION**

***ADVISORY ACTION***

1. The proposed amendments filed on November 20, 2008 have been fully considered and entered.

***Response to Arguments***

I. In page 6, third paragraph of applicant's remarks, applicant states that "[T]he specification has been amended to delete reference to U.S. Patent No. 7,090,804 and replace it with reference to U.S. Application No. 09/135,183, which was referenced in the application as filed. Applicants submit that No New Matter is introduced by way of this".

In view of the amended specification, the examiner agrees to withdraw the objection related to the specification.

II. In page 6, fourth paragraph bridging to page 8, third paragraph of applicant's remarks, applicant argues that "[W]hile the Examiner correctly notes that page 103 of the application states '[But] when correlated together, the data<sub>final</sub> can have a characteristic response that is unique to target analyte signals' and '[A] characteristic curve of the peak information means a positive' (see ¶¶ [0439], [0448] of US20040146909), one of skill in the art would understand the relationship of waveforms, electrodes and electron transfer based on the specification at the time the application was filed. The application repeatedly references voltammetric and spectrographic procedures, each of which connotes to the person of skill in the art the use of waveforms. See, e.g., 'Results' (¶¶ [0555] et seq. Moreover, one of skill in the art at the time of the application would recognize that energy occurs or can be measured by waveforms. For example, submitted herewith are pages from 'Electrochemical Methods' which describe basic electrode techniques<sup>1</sup>.

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As described herein, the voltammetric methods refer to the waveforms applied in the experiments and depicted in the figures. Thus, one of skill in the art would appreciate that the *very definition* of voltammetry involves the measurement of energy required to initiate electron transfer between donor and accepting molecules, at least one of which is typically affiliated with an electrode surface” and the background section, paragraphs [0006] and [0007] of the application reinforces this point.

After carefully considering above arguments, the examiner agrees to withdraw the new matter rejection on claim 25. However, the arguments are not persuasive toward the withdrawal of the new matter rejection on claims 11-13, 17, 18, and 20-24 because nowhere in paragraphs [0006], [0007], [0439], [0448], and [0555] of US20040146909 (US publication of this instant case) suggested by applicant describes that the input waveform eliciting a response of characteristic waveform that is unique to target analyte signals from the electrode is indicative of electron transfer between the electron transfer moiety and the electrode as recited in claim 11 and the electrode is not an accepting molecule.

2. Since applicant has not argued the rejections under 35 U.S.C 112, second paragraph, these rejections are proper and have been maintained.

3. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

/Frank W Lu /  
Primary Examiner, Art Unit 1634  
December 11, 2008